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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,550	03/26/2004	Toshiki Taguchi	Q80720	6141

23373 7590 10/23/2006

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/809,550

Applicant(s)

TAGUCHI ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1 and 2 have been amended, claims 3-6 have been deleted and new claim 7 has been added. Hence, claims 1, 2 and 7 are pending in the application.
2. The provisional obviousness-type double patenting rejection over copending Application No. 10/714,845 (now US Patent No. 7,083,664) as set forth in the previous Office Action dated August 22, 2006 has been overcome by applicant's amendment and is now withdrawn.
3. The provisional obviousness-type double patenting rejection over copending Application No. 10/503,764 (US 2005/0219339) as set forth in the previous Office Action dated August 22, 2006 has been overcome by applicant's amendment and is now withdrawn.
4. The provisional obviousness-type double patenting rejection over copending Application No. 10/504,029 (US 2005/0117006) as set forth in the previous Office Action dated August 22, 2006 has been overcome by applicant's amendment and is now withdrawn. New provisional obviousness-type double patenting rejection and obviousness-type double patenting rejections appear below.
5. The 102(a) rejection over EP1384762 as set forth in the previous Office Action dated August 22, 2006 has been overcome by the filing of a certified copy of applicant's foreign priority and is now withdrawn.

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6. The 102(b) rejection over EP0985716 as set forth in the previous Office Action dated August 22, 2006 has been overcome by the applicant's amendment and is now withdrawn.

7. The 102(e) rejections over Wachi (US 2003/0210310), Ozawa et al. (US 2004/0187734, Taguchi et al. (US 2004/0050291) and Taguchi et al. (US 2004/0053988 as set forth in the previous Office Action dated August 22, 2006 have been overcome by the filing of a certified copy of applicants foreign priority and are now withdrawn.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4 and 6-10 of U.S. Patent No.

7,014,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

Applicants should note that the above obviousness-type double patenting rejection was a provisional obviousness-type double patenting rejection over copending Application No. 10/404,435 in the previous Office Action dated August 22, 2006 but has been chanced since the application has now issued.

10. Claims 1, 2 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-5 of U.S. Patent No.

7,083,668. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

Applicants should note that the above obviousness-type double patenting rejection was a provisional obviousness-type double patenting rejection over copending Application No. 10/645,795 in the previous Office Action dated August 22, 2006 but has been chanced since the application has now issued.

11. Claims 1, 2 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-8 of U.S. Patent No.

7,037,365. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

Applicants should note that the above obviousness-type double patenting rejection was a provisional obviousness-type double patenting rejection over copending Application No. 10/645,797 in the previous Office Action dated August 22, 2006 but has been changed since the application has now issued.

12. Claims 1, 2 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9-13 of U.S. Patent No. 7,077,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

13. Claims 1, 2 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 10-12 of U.S. Patent No. 6,874,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

14. Claims 1, 2 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-5 and 7-9 of copending Application No. 10/508,792 (US 2005/0174409). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1, 2 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-6 of copending Application No. 10/808,464 (US 2004/0187736). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1, 2 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-15 of copending Application No. 11/360,611 (US 2005/0174409). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1, 2 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-10, 13, 15, 20, 21 and 24 of copending Application No. 10/503,894 (US 2005/0178288). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending application claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1, 2 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6 and 7 of copending Application No. 10/806,453 (US 2004/0187734). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending application claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In the above references, it is the examiner's position that it would have been obvious to one having ordinary skill in the art that: (1) the dyes contained in the ink have a solubility of 15 g or more in 100 g of water at 25°C under atmospheric pressure and/or (2) the oxidation potential of the at least one azo dye or phthalocyanine dye is more positive than 1.0 V (vs SCE) since the azo dyes and the phthalocyanine dyes of the above copending applications are the same structure as those claimed by applicants.

### ***Response to Arguments***

The examiner acknowledges that applicants are deferring to respond to the above provisional obviousness-type double patenting and obviousness-type double patenting rejection but it is the examiner's position that terminal disclaimers are now required to overcome the above rejections.

***Conclusion***

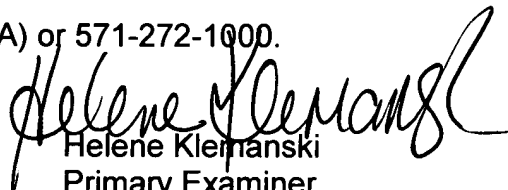
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
October 18, 2006